



UNITED STATES PATENT AND TRADEMARK OFFICE

#5

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

JAMES M. HESLIN, ESQ.
TOWNSEND and TOWNSEND and CREW LLP
TWO EMBARCADERO CENTER
8TH FLOOR
SAN FRANCISCO, CA 94111-3834

Paper No. 5

COPY MAILED

OCT 02 2000

OFFICE OF PETITIONS
A/C PATENTSDECISION REFUSING STATUS
UNDER 37 C.F.R. §1.47(a)

In re Application of
Chishti, et al.
Application No. 09/466,353
Filed: December 17, 1999
Title: Method and System for Incrementally
Moving Teeth

This is in response to the petition under 37 C.F.R. 1.47(a), filed September 12, 2000.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 C.F.R. §1.136(a).

The above-identified continuation application was filed on December 17, 1999, without an executed oath or declaration, missing the statutory basic filing fee and with additional claim fees due. Muhammad Chishti, Apostolos Lerios, Brian Freyburger, Kelsey Wirth, Richard Ridgley, Andrew Beers, and Chase Garfinkle, were named as joint inventors.

Accordingly, on February 9, 2000, a "Notice to File Missing Parts of Application" was mailed, requiring an executed oath or declaration with surcharge for late filing, the statutory basic filing fee and the additional claim fees. This Notice set a period for reply of two months from the mailing date of the notice, to April 9, 2000.

On September 12, 2000, (certificate of mailing on September 8, 2000), applicant filed two separate declarations for patent application signed, in total, by four¹ of the joint inventors; authorized payment of the surcharge for late filing and of the filing and claim fees due; and, timely paid for an extension of time for filing the response within the fifth month. Furthermore, applicant submitted a statement, subject to penalty under 18 U.S.C. §1001, that Andrew Beers and Chase Garfinkle were named as inventors in error, leaving Apostolos Lerios as the only non-signing joint inventor.

A declaration signed by less than all of the inventors is not a proper reply to the Notice to File Missing Parts. Nonetheless, petitioner avoided abandonment of the application by also applying for Rule 47 status.

Rule 47 applicant maintains that status under 37 C.F.R. §1.47(a) is proper because joint inventor Apostolos Lerios refuses to join in the application for patent.

A grantable petition under 37 C.F.R. §1.47(a) requires: (1) proof that the non-signing inventor

¹ The signing inventors are Muhammad Chishti, Brian Freyburger, Kelsey Wirth and Richard Ridgley.

cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor.

The declaration submitted is in compliance with 35 U.S.C. §§115 and 116. Payment of the petition fee has been charged to the Deposit Account, as authorized. The petition included a statement of the last known residence address of Apostolos Lerios.

However, because applicant lacks item (1), set forth above, rule 47(a) status is refused. A review of the supporting declarations of James Heslin and Bao Tran indicate that the non-signing inventor was only presented with the declaration and assignment in this application. Specifically, on March 22, 2000, Mr. Lerios was sent via the assignee a declaration and assignment to sign (Exhibit B). On June 21, 2000, Mr. Lerios was sent via certified-return receipt mail a copy of the PCT application prepared in 1998, and a declaration and assignment to sign (Exhibit C). On August 11, 2000, Mr. Lerios was sent via certified-return receipt mail another copy of the declaration and assignment (Exhibit D). The enclosures noted on the accompanying cover letters do not include specifications, claims and drawings of the application filed December 17, 1999. Unless Mr. Lerios was also presented with a copy of the papers (specification, claims and drawings) in this application, Mr. Lerios could not sign the declaration, which requires that he attest that he has "reviewed and understands the contents of the above-identified specification, including the claims." Accordingly, Rule 47 applicant has failed to show or provide proof that the inventor refused to sign the declaration within the meaning of 37 C.F.R. §1.47(a).

On Request for Reconsideration, given the deficiencies noted:

Petitioner must establish that a copy of the papers (specification, claims and drawings) in this application has been presented to the inventor, but that he did not respond to the request that he sign the declaration or that he refused to sign the declaration. The proof of the pertinent events should be made by a statement of someone with first hand knowledge of the events.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries related to this decision may be directed to Petitions Attorney Nancy Johnson at (703) 305-0309.

Beverly M. Managan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy